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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,997	04/09/2001	Zion Azar	127/02185	1331

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PRTSI
P.O. Box 16446
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EXAMINER	
JOHNSON III, HENRY M	
ART UNIT	PAPER NUMBER
3739	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

MR

Office Action Summary	Application No.	Applicant(s)	
	09/828,997	AZAR, ZION	
	Examiner	Art Unit	
	Henry M. Johnson, III	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3,5-7,30-38,41 and 42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3,5-7,30-38,41 and 42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

Response to Arguments

Applicant's arguments filed October 31, 2007 have been fully considered and are persuasive with regard to the 35 U.S.C. § 102 rejections. Therefore, the rejections have been withdrawn. However, upon further consideration, new grounds of rejection are made.

Chen et al. as used in prior rejections clearly discloses heating in the methods cited in the application. U.S. Patent 5,595,568 to Anderson et al. teaches the use of optical radiation to heat hair follicles for removal of hair. Anderson et al., in the paper disclosed in the Applicant's background written in 1983, discloses the temperatures at which tissue exhibits various properties associated with treatment. Rejections based on Chen et al. and both the Anderson et al. patent and paper are provided below.

Further review by the examiner has uncovered a new matter issue in that the original disclosure provided no clearly disclosed method for hair removal nor a second temperature sufficient to remove hair. The temperature for hair removal was included in the amendment of September, 2004, however, was overlooked by the previous examiner.

It is arguable as to whether the disclosure is enabled as it is written in a generic manner to heat tissue using the specific method steps with no specific method disclosed for hair removal. The original disclosure specifically cites varicose veins, psoriasis and port wine stains

(see pages 14, 16 and 30), but not hair removal. The only reference to hair removal is in the drawing descriptions in describing the apparatus. If it is considered enabled for hair removal due to the generic steps, then it would be obvious for one of skill in the art to combine the references cited for hair removal.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 5-7, 30-38, 41 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The method requiring a temperature sufficient for removal of hair is new matter not in the original disclosure. The Applicant's amendment of February 2004 amended claim 39 to include the limitation. The new limitation also then lacks antecedent basis in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30, 32-34 37, 38, 41 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 30, 32-34 37, 38 and 42 are indefinite for depending on a cancelled claim.

In claims 41 and 42 the term "substantially higher" is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 5-7, 30-38, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,814,008 to Chen et al. in view of U.S. Patent 5,595,568 to Anderson et al. and further in view of Selective Photothermolysis: Precise Microsurgery by Selective Absorption of Pulsed Radiation, by R. Rox Anderson; John A. Parrish; Science © 1983 American Association for the Advancement of Science. Chen et al. teach a method of treating tissue using two energy sources, one to heat the treatment site to enhance the perfusion of a photoreactive reagent into the tissue and the other source being a light with a waveband that overlaps that of the absorption of the reagent to effect photo treatment (Col. 2, lines 55-67). The initial heat is clearly prior to the photoactivation of the reagent. It is well known that the targeting of a photosensitizing reagent heats the target tissue and since the reagent is selectively absorbed by the target, the target tissue is selectively heated to a higher temperature. Chen et al. disclose the energy source may be LEDs, laser diodes, electroluminescent devices, resistive filament lamps (broadband), or vertical cavity surface emitting lasers. The LEDs operating by pulses (Col. 8, lines 1-2) resulting in pulsed radiation. Chen et al. do not teach hair as a target tissue nor specific temperatures for the target tissue. The Anderson et al. patent specifically relates to hair removal by heating of the target to a

temperature between 80 and 100 degrees centigrade, a temperature that leads to permanent damage and subsequent removal (Col. 7, lines 4-6). The Anderson/Parrish paper teaches the treatment of tissue using pulsed radiation that is selectively absorbed causing localized heating. Anderson/Parrish disclose that when heating above 60 °C to 70 °C, structural proteins, including collagens are denatured, above 70 °C to 80 °C, nucleic acids are denatured and membranes become permeable and above 70 °C to 100 °C, coagulation necrosis results. Thus, one of skill in the art is able to use the teachings of Anderson/Parrish to control the desired results. It would have been obvious to one skilled in the art to use the temperatures as taught by Anderson/Parrish to target hair tissue as taught by the Anderson et al. patent in the methods of Chen et al. to effect the desired treatment.

The collective teachings available to one of skill in the art would clearly allow such a person to develop a predictable method for hair removal routine experimentation.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3, 5-7, and 30-37 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 8-12 of U.S. Patent No. 5,759,200. Although the conflicting claims are not identical, they are not patentably distinct from each other because the steps represent obvious changes in scope. The term further heating the target in the patent clearly indicates this step is after the heating of the general area and target. The method steps are essentially identical with the exception of the intended target tissue. A skilled artesian would consider obvious to use the generic methodology for any tissue treatment where changes in temperature effect the desired outcome. Hair removal is an obvious target.

Claims 3, 5-7 and 30-32 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 40 and 48 of U.S. Patent No. 6,2144,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because the steps represent obvious changes in scope. The term further heating the target in the patent clearly indicates this step is after the heating of the general area and target. The method steps are essentially identical with the exception of the intended target tissue. A skilled artesian would consider obvious to use the generic methodology for any tissue treatment where changes in temperature effect the desired outcome. Hair removal is an obvious target.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Henry M. Johnson, III
Primary Examiner
Art Unit 3739